

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte RONALD A. KRAMER

Appeal No. 1999-1148  
Application No. 08/665,491

HEARD: December 12, 2001

Before, WARREN, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 13, 15-18 and 20, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a method for treating a wiper blade by applying a composition containing one or more specified sulfonic acids or a salt thereof to a wiping surface of the blade. An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below.

13. Process for treating a rubber, a thermoplastic elastomer, or a plastic wiper blade comprising  
applying a composition including one or more sulfonic acids or salt thereof to the wiping surface of said wiper blade, said sulfonic acid having from about 2 to about 36 carbon atoms.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Palcher	3,956,174	May 11, 1976
Bright et al. (Bright)	3,978,010	Aug. 31, 1976
Liddle	3,998,643	Dec. 21, 1976

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Liddle in view of Palcher. Claims 15-18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liddle in view of Palcher and Bright.

We refer to appellant's brief and reply brief and to the examiner's answer for an exposition of the respective viewpoints expressed by appellant and the examiner concerning the rejections.

#### OPINION

Upon careful review of the entire record including the respective positions advanced by appellant and the examiner with respect to the rejections before us for review, we find ourselves in agreement with appellant that the examiner has failed to carry

the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejections, as stated.

We point out that in a rejection under 35 U.S.C. § 103, it is basic that all elements recited in a claim must be considered and given effect in judging the patentability of that claim against the prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). Claim 13, the only independent claim on appeal, requires that a composition including a sulfonic acid having from about 2 to about 36 carbon atoms is applied to a wiping surface of a wiper blade.

In rejecting claim 13, the examiner has applied Liddle for disclosing the treatment of non-porous surfaces including plastics and glass with a composition including an alkylpolysiloxane, hydrofluoric acid and a mineral acid, which may be selected from a list of acids including alkyl sulfonic acids and aromatic sulfonic acids. The examiner (answer, page 4) points to column 4, lines 1-34 of Liddle and notes that Liddle discloses the treatment of an automobile windshield with the composition. The examiner lists several advantageous effects of

such treatment that are allegedly disclosed by Liddle. Notwithstanding the automobile windshield treatment disclosed by Liddle, the examiner has made the factual determination that Liddle does not teach treating a windshield wiper blade with such a composition (answer, page 4).

The examiner refers to Palcher for disclosing the treatment of rubber, such as the rubber of an automobile tire, with an alkylpolysiloxane composition to protect against environmental damage posed by ozone and UV radiation.

From the above-noted teachings of Palcher and Liddle, the examiner concludes that:

[I]t would have been obvious to one of ordinary skill in the art to apply the treating method of Liddle to a windshield wipers, as well as the disclosed windshield, in order to obtain the water and dirt repellency as taught by Liddle, and to further obtain the rubber protection against environmental damage, as taught by Palcher.

Here, the examiner has failed to address much less explain how the combined references' teachings would have led one of ordinary skill in the art to the use of a composition including a sulfonic acid having the number of carbon atoms specified in claim 13. Failure to address all of the claim limitations is fatal to a rejection under 35 U.S.C. § 103. Accordingly, the

examiner has failed to present a prima facie case of obviousness on that basis alone.

Moreover, the examiner has failed to provide sufficient specific support for the proposed modification of the method of Liddle on this record. The examiner has only made general statements with regard to the teachings of Liddle concerning treatment of an automobile windshield with a sulfonic acid containing composition and Palcher concerning treating rubber materials such as found in a tire with an alkylpolysiloxane composition (answer, page 4) without delineating why one of ordinary skill in the art would have been led by those disparate disclosures to treat a wiper with the composition of Liddle with a reasonable expectation of success in so doing.

The examiner's assertion (answer, page 6) that "one of ordinary skill would have reasonably expected the significantly similar compositions of Liddle and Palcher to provide the treatment effects disclosed in those references on both types of materials, i.e. porous and non-porous" is not supported by a comparison of the quite different compositions disclosed in those references. For example, the composition of Liddle includes two acids while the composition of Palcher does not include an acid component. In this context, the examiner's rejection falls short

in not identifying a convincing and particularized suggestion, reason or motivation to combine the references or make the proposed modification in a manner so as to arrive at the claimed invention. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

With regard to the separate § 103 rejection of dependent claims 15-18 and 20, the examiner additionally relies on Bright for allegedly evidencing " . . . that sulfonic acids of the type recited in the instant claims were known as useful in cleaning compositions" (answer, paragraph bridging pages 4 and 5). The examiner does not explain, with any particularity, why one of ordinary skill in the art would have been led to modify the water and soil repellant composition of Liddle based on the teachings of Bright regarding cleaning compositions. Indeed, our review of Bright reveals that an amine salt of an anionic linear alkylated aryl sulfonic acid is used in the cleaning formula of Bright not an acid or metal salt as called for in claims 15-18 and 20.

For the foregoing reasons, we find that the examiner has not established a prima facie case of obviousness. Because we reverse on this basis, we need not reach the issue of the countervailing evidence discussed by appellant at pages 5-10 of the brief or the sufficiency of the asserted showing of

unexpected results (brief, page 11).<sup>1</sup> See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Remand

We note that during patent examination, the claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In other words, during *such ex parte* prosecution, "the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicants' specification." See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Looking at the "applying" step as recited in appellant's claims in that light and giving that term its' broadest reasonable meaning, we determine that term does not require any particular method of application of the composition to the wiper blade wiping

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<sup>1</sup> We note that the examiner has not favored us with his views on the four patents and unexpected results evidence referenced in appellant's brief.

surface.<sup>2</sup> We observe that Bright teaches the use of a cleaning composition including an amine salt of specified sulfonic acids for cleaning automobile windshields and indicates that the cleaning fluid may be supplied through a vehicle washing unit. See column 6, lines 23-62 and Table 1 of Bright.

Accordingly, we remand this application to the examiner to determine whether or not Bright would have inherently taught or reasonably suggested running the wipers during the windshield washing discussed therein so as to apply the washing fluid including an amine salt of a sulfonic acid to the wiping surface of the wiper blade. The examiner should determine whether or not that prior art alone or taken together with any other prior art would have rendered the subject matter of claim 13 or any other claim unpatentable.

Regarding all of the appealed claims, we note that many neutralized sulfonic acids such as metal salts of sulfonic acids are known to be useful as detergents. See the definitions of alkyl sulfonate linear and sodium dodecylbenzenesulfonate in

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<sup>2</sup> We note that the specification does not define the term "applying". Indeed, see page 11, lines 16-33 of the specification wherein it is indicated that the treating composition may be applied to the wiper blade in a variety of ways.




Hawley, The Condensed Chemical Dictionary, 8th ed. (1971), Van Nostrand Reinhold Company, pp. 28, 29 and 800 (copy attached). The examiner should determine whether or not such neutralized sulfonic acids that are within the scope of appellant's claimed sulfonic acid salt are present in prior art cleaning preparations useful for washing a car and whether or not the use of such detergents for applying to windshield wiper wiping surfaces for cleaning thereof would have been rendered obvious thereby. If so, a rejection of the here claimed invention under 35 U.S.C. § 103 based on any such prior art should be considered.

The decision of the examiner to reject claim under 35 U.S.C. § 103(a) as being unpatentable over Liddle in view of Palcher and to reject claims 15-18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Liddle in view of Palcher and Bright is reversed.

CHARLES E. WARREN

  
PETER F. KRATZ  
Administrative Patent Judge

  
JEFFREY T. SMITH  
Administrative Patent Judge

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